UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,616	07/11/2000	Robert Baranowski	06662.007	1178

20480 7590 04/27/2006

STEVEN L. NICHOLS
RADER, FISHMAN & GRAVER PLLC
10653 S. RIVER FRONT PARKWAY
SUITE 150
SOUTH JORDAN, UT 84095

EXAMINER	
QURESHI, AFSAR M	
ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/613,616	BARANOWSKI, ROBERT	
	Examiner	Art Unit	
	Afsar M. Qureshi	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24,26-35 and 38-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24,26-35 and 38-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office action is responsive to amendment/election (dated 2/22/2006) of Group III (claims 24, 26-35) as required by Office action mailed on 1/25/2006. The Examiner acknowledges additional (new) claims 38-41.

Response to Arguments

2. Applicant's arguments, see Remarks /election, filed 2/22/2006, with respect to claims 24, 26-35 have been fully considered and are not persuasive. Due to amendments to claims, as elected, the Examiner found new grounds of rejection. Consequently, this action is made non-final.

In the above argument, Applicant traverses Requirement for election/restriction (1/25/2006) and requested further explanation as to why there would be an extra burden imposed on Examiner in view of the restriction. However, it has been explained fully in paragraphs 2-4 of said Election/Restriction. A renewed and thorough search is required for each application based on invention and claimed subject matter even in the presence of a prior search conducted for a parent application.

Also, the Applicant argued (see Arguments dated 10/6/2005) that cited reference (Ayanoglu et al. US 6,122,759) fails to disclose at least the limitation "*wherein a functionality of said portable device is altered in response to said determined location*" (claim 24). Examiner contends that Ayanoglu discloses same subject matter in col. 9,

lines 38-67 through to col. 10, lines 1-4, whereby functionality, such as connectivity, of a mobile is altered in accordance with location.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 38-41 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-17 of U.S. Patent No. US 6,813,608 (Baranowski). Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 15-17 also contain same subject matter "a portable device displaying map (claim 15, lines 16,17), comprising an indication of a

location (claim 15, lines 18, 19) and displaying directions to location (claim 15, lines 20-24). Same similarities are also found in claims 16 and 17.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 24 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Ayanoglu et al. (US 6,122,759), hereinafter 'Ayanoglu'.

Ayanoglu discloses a system including a wireless data LAN supporting portable devices (fig. 3) and access points or portable base stations 22 and devices 28, a processor for determining a location of a portable device based on transmissions received by any of a plurality of access points from any of said portable devices (see col. 9, lines 38-51). The processor may be in the wireless portable device or within an access point or other network devices. The functionality of portable device is changed in response to current location (see col. 9, lines 38-67 through col. 10, lines 1-4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 26 - 28, 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ayanoglu as applied to claims 24, 29 above, and further in view of Motohashi (US 6,351,639).

Ayanoglu does not explicitly disclose setting up ringer volume according to determined location. However, Motohashi discloses providing different features including setting up ringer volume subject to information restored in a predetermined location (see col. 12, lines 9-48, col. 15, lines 30-35).

Motohashi further discloses wireless phone unit (portable cellular phone 1b, figs. 1 and 3) having voice messaging features (see col. 5, lines 1-3 and lines 17-45)

Therefore, it would have been obvious to one skilled in the art, at the time of invention, to utilize telephone settings (voice, ringer volume etc.) in a portable cellular phone capable of functions, stored therein, to change settings according to determined location in order to permit changing of settings without introduction of an element of inconvenience.

6. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ayanoglu as applied to claim 29 above, and further in view of Chen et al. (US 5,440,740).

The portable devices disclosed in the invention by Ayanoglu are functionally considered as the claimed personal digital assistant (a cellular phone). However, Ayanoglu does not specifically disclose a system that alerts a forthcoming event and consequently, adjusting amount of time prior to scheduled event. Chen discloses software techniques in a central digital signaling processor representing an alarm clock that sounds at a predetermined time to alert the user of a scheduled event (fig. 13, col. 20, lines 5-26).

Therefore, it would have been obvious to one skilled in the art, at the time of invention, to utilize similar software techniques, within the portable devices of Ayanoglu, as disclosed by Chen in order to enhance resource management.

7. Claims 38-41are rejected under 35 U.S.C. 103(a) as being unpatentable over Ayanoglu as applied to claims 24 and 29 above in view of Nimura et al. (US 5,890,088).

The portable devices, mobile units and laptop computer (figure 1 and 2), disclosed by Ayanoglu, have display area, however, Ayanoglu does not specifically disclose that these units display a map and directions to locations as claimed herein. These features, nonetheless are commonly used in auto navigations based on generally available software. Nimura discloses portable electronic devices that input a map of the

vicinity of the destination and directions to required location (see col. 6, lines 32-55 and lines 65 through col. 7, lines 1-24, figures 9, 10 and 11).

Invention by Nimura is in the same field of endeavor therefore, it would have been obvious to one skilled in the art, at the time of invention, to be able to configure portable devices of Ayanoglu by utilizing similar control units for exchange of data, displaying map and directions, as disclosed by Nimura. An obvious motivation for this modification would have been to provide an instant guidance of locations on a map.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fuccello et al. (US 2002/0019985), Communications Network With Wireless Gateways for Mobile Terminal Access.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Afsar M. Qureshi whose telephone number is (571) 272 3178. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272 7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4/25/2006

AFSAR QURESHI
PRIMARY EXAMINER